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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,539	01/11/2002	Thomas R. Cech	015389-002630US	4930
34151	7590	05/06/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW LLP			LIETO, LOUIS D	
8TH FLOOR			ART UNIT	
TWO EMBARCADERO CENTER			PAPER NUMBER	
SAN FRANCISCO, CA 94111			1632	

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/044,539

Applicant(s)

CECH ET AL.

Examiner

Louis D. Lieto

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 36-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/11/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's response filed on 4/11/2005 is acknowledged. Claims 1-33 and 36-40 are pending in the instant application. Applicants canceled claims 34 and 35, amended claims 1 and 37, and added claims 38 and 40. The sections of title 35 U.S.C not included in this office action can be found in a previous office action. An action on the merits follows.

### ***Priority***

The original determination that claims 6-33 and 36 are not disclosed in the parent application 08/854,050 is maintained for reasons of record stated in the action of 11/02/2004. Applicant's response filed 4/11/2005 did not raise any arguments about this determination.

### ***Claim Rejections - 35 USC § 112***

The rejection of original, amended, or new claims 1-33, and 36-40 under 36 U.S.C. 112, first paragraph, for scope of enablement, is withdrawn. Applicant's amendments and arguments filed 9/21/2004 have been fully considered and were found persuasive in overcoming the remaining grounds of rejection.

The 1. 132 declaration by Gregg B. Morin filed on 4/11/2005 has been considered.

### ***Double Patenting***

The rejections of original, amended, or new claims 1-33, and 36-40 under the judicially created doctrine of obviousness-double patenting, over US Patent Application NO: 09/721,477,

Art Unit: 1632

US Patent NO: 6,261,836 and US Patent NO: 6,337,200 are maintained. Applicant's arguments filed 4/11/2005 have been fully considered but they are not persuasive.

Applicant stated in their response, filed 4/11/2005, that US Patent Application NO: 09/721,477, is less advanced in prosecution than the present case and that the question of double patenting will not arise when this application is otherwise in condition for allowance. It is unclear if applicant is cryptically implying they will abandon 09/721,477 or file a terminal disclaimer. However, the Office does not hold rejections in abeyance. A proper response to a rejection requires that Applicant fully address the rejection. A statement that Applicant will otherwise resolve this issue is not considered to be a complete and proper response. The rejection is maintained for reasons of record as set forth in the office action of 11/02/2004.

In the response filed 4/11/2005, applicants acknowledge the rejection over US Patent NO: 6,261,836 and state that they will "undertake to file a Terminal Disclaimer or otherwise address this issue once the office indicates that the application is otherwise in condition for allowance." Applicant's argument that they will either file a Terminal Disclaimer or otherwise address the issue is acknowledged. This rejection is maintained for reasons of record as set forth in the office action of 11/02/2004.

In the response filed 4/11/2005, applicants disagree with the double patenting rejection over US Patent NO: 6,337,200. However, applicants do not provide any substantive arguments to support their point of view. Instead they argue that it is "unfair" to the owners of the invention

Art Unit: 1632

claimed here to be subject to the complications of a double patenting rejection simply because US Patent NO: 6,337,200 shares a common inventor. Applicants' contention that the double patenting rejection is "unfair" is not considered to be a substantive response to the rejection. Further, if there is a common assignee or inventor between the application and patent, a double patenting rejection must be made. See MPEP § 804. Therefore this rejection is maintained for reasons of record as set forth in the office action of 11/02/2004.

No Claims Allowed

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547. Any inquiry concerning this communication or earlier

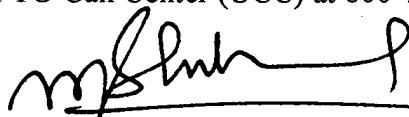
Art Unit: 1632

communications from the examiner should be directed to Dr. Lou Lieto whose telephone number is (571) 272-2932. The examiner can normally be reached on Monday-Friday, 9am-5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is (571)-272-0735. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Patent applicants with problems or questions regarding electronic images that can be viewed in the PAIR can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Dr. Louis D. Lieto  
Patent Examiner  
Art Unit 1632

  
**RAM R. SHUKLA, PH.D.**  
**SUPERVISORY PATENT EXAMINER**